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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/785,559	01/17/97	WEINRICH A	9275.2

LM01/1030
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EXAMINER
HAVAN, I

ART UNIT PAPER NUMBER
2771

DATE MAILED: 10/30/98

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/785,559

Applicant(s)
Weinrich et al.

Examiner
Thu-Thao Havan

Group Art Unit
2771



☒ Responsive to communication(s) filed on Jan 17, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

2. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because the grounds that the corrections proposed by Applicant were too numerous to be entered by the clerical staff.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

3. The Microfiche Appendix (7 films) was not enclosed. Please submit the microfiche as indicated in the "New Application Transmittal" form.

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4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: a confirmed defined relationship or a denied defined relationship.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. As to claims 1, 6, 17, and 26, Shaw et al. discloses a confirmed defined relationship or a denied defined relationship (**column 9, lines 23-33; column 17, lines 4-22**). In the interest of compact prosecution it is assumed that the terms "confirmed or denied relationships" means when the e-mail is in an active or an inactive stage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-5, 7-16, 18-25, 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US Patent No.5,809,242) in view of Rothschild (US Patent No.5,822,523).

8. As to claim 1, the prior art Shaw et al discloses: a.) a database connectivity engine connected to the web server (**column 9, lines 1-10**) b.) a mail server (**column 9, lines 40-60**), and c.) a confirmed defined relationship or a denied defined relationship (**column 10, lines 20-50**). However, Shaw fails to explicitly teach a queue watcher coupled to database server for queuing outgoing e-mails.

Rothschild teaches a queue watcher coupled to database server for queuing outgoing e-mails (**column 9, lines 40-60**). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a queue watcher coupled to database server for queuing outgoing e-mails as taught by Rothschild to the advertising electronic mail system of Shaw; so that the advertising electronic mail system have a queue watcher coupled to database server for queuing outgoing e-mails.

9. As to claim 15, Rothschild discloses: a.) a first user and a second user from first set of data (**column 8, lines 20-35**), b.) the transmitting of a first e-mail to second user (**column 8, lines 48-60**), and c.) a second input and record (**column 10, lines 1-20**).

10. As to claim 25, Rothschild discloses: a.) an input of data and transmitting an outgoing e-mail (**column 2, lines 15-25**), b.) a relationship between first user and second user (**column 3, lines 5-20**), and c.) a second data input from second user in response to first e-mail (**column 4, lines 1-25**).

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11. As to claim 2, Shaw discloses a formcode to update or generate records in the database (**column 6, lines 8-35**).
12. As to claim 3 and 28, Shaw discloses a user to the web server (**column 2, lines 10-20; column 11, lines 27-43**).
13. As to claim 4, Shaw discloses an incoming and outgoing e-mail (**column 2, lines 55-67; column 9, lines 40-50**).
14. As to claim 5, Rothschild discloses a relationship between first and second user (**column 3, lines 5-20**).
15. As to claim 13, Rothschild discloses a demographic data and a relationship data (**column 11, lines 10-26**).
16. As to claim 18 and 27, Rothschild discloses an e-mail from the second user (**column 10, lines 50-60**).
17. The limitations of claims 7-12, 14, 16, 19-24, and 29-31 have been discussed in the rejection of claims 1, 15, and 25. They are therefore rejected as set forth above.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
19. Kuzma, US Patent 5,781,901 is considered relevant because it disclosed the sender requests an e-mail from a recipient.

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20. Otorii, US Patent 5,632,018 is considered relevant because it disclosed the user sends the e-mail to an identifier user or users.
21. Hussey, US Patent 5,826,269 is considered relevant because it disclosed the electronic mail interface for a network server.
22. Herz et al., US Patent 5,754,938 is considered relevant because it disclosed electronic identification of desirable objects to the senders.
23. Smith et al., US Patent 5,790,790 is considered relevant because it disclosed the electronic document delivery system that sends to a particular recipient.
24. Goldhaber et al., US Patent 5,794,210 is considered relevant because it disclosed an advertisement e-mail system to the users.

Inquires

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Thu-Thao Havan whose telephone number is (703) 308-7062. The examiner can normally be reached on Monday through Thursday from 7:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached on (703) 305-9707.

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Any response to this action should be mailed to:

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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9731 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-9600.

Thu-Thao Havan


WAYNE AMSBURY
PRIMARY PATENT EXAMINER